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ISL0007-US (541437-0000007)

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

ROBERT WIEST ET AL.

Serial No.: 10/542,174

Filed: JULY 14, 2005

For: TRANSACTION SERVER AND
COMPUTER PROGRAMME
PRODUCT

Art Unit: 3621

Examiner: Not Yet Assigned

**SUBMISSION OF TRANSLATION OF INTERNATIONAL PRELIMINARY
EXAMINATION REPORT**

Office of Initial Patent Examination
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant is submitting herewith a translation of the International Preliminary Examination Report received in applicant's corresponding International Application PCT/DE00/01584 of the above-identified application for entry into the Office records.

The Commissioner is hereby authorized to charge any additional fees associated with this communication or credit any overpayment to applicant's representative's Deposit Account No. 03-3975. A duplicate copy of this paper is attached for that purpose.

It is respectfully submitted that the application is now complete and it is respectfully requested that the subject application be placed upon the files for examination.

Serial No.: 10/542,174
Art Unit: 3621
Inventor: Robert WIEST et al.

Attorney's Docket No.: ISL0007-US
Page 2

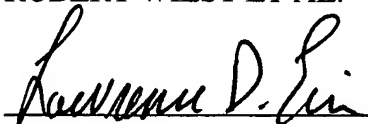
PILLSBURY WINTHROP SHAW PITTMAN LLP
1650 Tysons Boulevard
McLean, VA 22102
Tel: 703/770-7900

Respectfully submitted,

ROBERT WIEST ET AL.

Date: June 16, 2006

By:

 (41,009)
Michael Bednarek
Registration No. 32,329

MB/ggb

Customer No. 00909

From the INTERNATIONAL BUREAU

PCT

NOTIFICATION OF TRANSMITTAL
OF COPIES OF TRANSLATION
OF THE INTERNATIONAL PRELIMINARY REPORT
ON PATENTABILITY
(CHAPTER I OR CHAPTER II
OF THE PATENT COOPERATION TREATY)
(PCT Rules 44bis.3(c) and 72.2)

To:

VOGEL, Dany
Isler & Pedrazzini AG
Gotthardstrasse 53
Postfach 6940
CH-8023 Zürich
SUISSE

EINGEGANGEN

12 Mai 2006

Date of mailing (day/month/year) 11 May 2006 (11.05.2006)	
Applicant's or agent's file reference P143437 DV/MR	IMPORTANT NOTIFICATION
International application No. PCT/CH2004/000462	International filing date (day/month/year) 22 July 2004 (22.07.2004)
Applicant SWISS REINSURANCE COMPANY et al	

1. Transmittal of the translation to the applicant.



The International Bureau transmits herewith a copy of the English translation of the international preliminary report on patentability (Chapter I).



The International Bureau transmits herewith a copy of the English translation of the international preliminary report on patentability (Chapter II).

2. Transmittal of the copy of the translation to the designated or elected Offices.

The International Bureau notifies the applicant that copies of that translation have been transmitted to the following designated or elected Offices requiring such translation:

None

The following designated or elected Offices, having waived the requirement for such a transmittal at this time, will receive copies of that translation from the International Bureau only upon their request:

AE, AG, AL, AM, AP, AT, AU, AZ, BA, BB, BG, BR, BW, BY, BZ, CA, CH, CN, CO, CR, CU, CZ, DE, DK, DM, DZ, EA, EC, EE, EG, EP, ES, FI, GB, GD, GE, GH, GM, HR, HU, ID, IL, IN, IS, JP, KE, KG, KP, KR, KZ, LC, LK, LR, LS, LT, LU, LV, MA, MD, MG, MK, MN, MW, MX, MZ, NA, NI, NO, NZ, OA, OM, PG, PH, PL, PT, RO, RU, SC, SD, SE, SG, SK, SL, SY, TJ, TM, TN, TR, TT, TZ, UA, UG, US, UZ, VC, VN, YU, ZA, ZM, ZW

3. Reminder regarding translation into (one of) the official language(s) of the elected Office(s).

The applicant is reminded that, where a translation of the international application must be furnished to an elected Office, that translation must contain a translation of any annexes to the international preliminary report on patentability (Chapter II).

It is the applicant's responsibility to prepare and furnish such translation directly to each elected Office concerned within the applicable time limit (Rule 74.1). See Volume II of the PCT Applicant's Guide for further details.

The International Bureau of WIPO 34, chemin des Colombettes 1211 Geneva 20, Switzerland	Authorized officer Yolaine Cussac
Facsimile No.+41 22 740 14 35	Facsimile No.+41 22 338 70 80

PATENT COOPERATION TREATY

PCT

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY (Chapter I of the Patent Cooperation Treaty)

(PCT Rule 44bis)

Applicant's or agent's file reference P143437 DV/MR	FOR FURTHER ACTION	See item 4 below
International application No. PCT/CH2004/000462	International filing date (<i>day/month/year</i>) 22 July 2004 (22.07.2004)	Priority date (<i>day/month/year</i>) 31 July 2003 (31.07.2003)
International Patent Classification (8th edition unless older edition indicated) See relevant information in Form PCT/ISA/237		
Applicant SWISS REINSURANCE COMPANY		

1. This international preliminary report on patentability (Chapter I) is issued by the International Bureau on behalf of the International Searching Authority under Rule 44 *bis*.1(a).

2. This REPORT consists of a total of 13 sheets, including this cover sheet.

In the attached sheets, any reference to the written opinion of the International Searching Authority should be read as a reference to the international preliminary report on patentability (Chapter I) instead.

3. This report contains indications relating to the following items:

- | | | |
|-------------------------------------|--------------|---|
| <input checked="" type="checkbox"/> | Box No. I | Basis of the report |
| <input checked="" type="checkbox"/> | Box No. II | Priority |
| <input type="checkbox"/> | Box No. III | Non-establishment of opinion with regard to novelty, inventive step and industrial applicability |
| <input type="checkbox"/> | Box No. IV | Lack of unity of invention |
| <input checked="" type="checkbox"/> | Box No. V | Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement |
| <input type="checkbox"/> | Box No. VI | Certain documents cited |
| <input checked="" type="checkbox"/> | Box No. VII | Certain defects in the international application |
| <input type="checkbox"/> | Box No. VIII | Certain observations on the international application |

4. The International Bureau will communicate this report to designated Offices in accordance with Rules 44bis.3(c) and 93bis.1 but not, except where the applicant makes an express request under Article 23(2), before the expiration of 30 months from the priority date (Rule 44bis .2).

The International Bureau of WIPO 34, chemin des Colombettes 1211 Geneva 20, Switzerland	Date of issuance of this report 01 May 2006 (01.05.2006)
Facsimile No. +41 22 740 14 35	Authorized officer <div style="text-align: center; font-weight: bold; margin: 10px 0;">Yolaine Cussac</div> Telephone No. +41 22 338 70 80

PATENT COOPERATION TREATY

Translation

From the
INTERNATIONAL SEARCHING AUTHORITY

PCT

WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY

(PCT Rule 43bis.1)

To:

Date of mailing
(day/month/year)

Applicant's or agent's file reference P143437 DV/MR	FOR FURTHER ACTION See paragraph 2 below
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International application No. PCT/CH2004/000462	International filing date (day/month/year) 22.07.2004	Priority date (day/month/year) 31.07.2003
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International Patent Classification (IPC) or both national classification and IPC

Applicant
SWISS REINSURANCE COMPANY

1. This opinion contains indications relating to the following items:

- ☒ Box No. I Basis of the opinion
- ☒ Box No. II Priority
- ☐ Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- ☐ Box No. IV Lack of unity of invention
- ☒ Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- ☐ Box No. VI Certain documents cited
- ☒ Box No. VII Certain defects in the international application
- ☐ Box No. VIII Certain observations on the international application

2. FURTHER ACTION

If a demand for international preliminary examination is made, this opinion will be considered to be a written opinion of the International Preliminary Examining Authority ("IPEA") except that this does not apply where the applicant chooses an Authority other than this one to be the IPEA and the chosen IPEA has notified the International Bureau under Rule 66.1bis(b) that written opinions of this International Searching Authority will not be so considered.

If this opinion is, as provided above, considered to be a written opinion of the IPEA, the applicant is invited to submit to the IPEA a written reply together, where appropriate, with amendments, before the expiration of 3 months from the date of mailing of Form PCT/ISA/220 or before the expiration of 22 months from the priority date, whichever expires later.

For further options, see Form PCT/ISA/220.

3. For further details, see notes to Form PCT/ISA/220.

Name and mailing address of the ISA/EP	Authorized officer
Facsimile No.	Telephone No.

WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY

International application No.

PCT/CH2004/000462

Box No. I

Basis of this opinion

1. With regard to the language, this opinion has been established on the basis of the international application in the language in which it was filed, unless otherwise indicated under this item.
☐ This opinion has been established on the basis of a translation from the original language into the following language
_____, which is the language of a translation furnished for the purposes of international search (under Rule 12.3 and 23.1(b)).
2. With regard to any nucleotide and/or amino acid sequence disclosed in the international application and necessary to the claimed invention, this opinion has been established on the basis of:
 - a. type of material
☐ a sequence listing
☐ table(s) related to the sequence listing
 - b. format of material
☐ in written format
☐ in computer readable form
 - c. time of filing/furnishing
☐ contained in the international application as filed.
☐ filed together with the international application in computer readable form.
☐ furnished subsequently to this Authority for the purposes of search.
3. ☐ In addition, in the case that more than one version or copy of a sequence listing and/or table(s) relating thereto has been filed or furnished, the required statements that the information in the subsequent or additional copies is identical to that in the application as filed or does not go beyond the application as filed, as appropriate, were furnished.
4. Additional comments:

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Box No. II

Priority

1. ☒ The following document has not yet been furnished:

☒ copy of the earlier application whose priority has been claimed (Rule 43bis.1 and 66.7(a)).

☐ translation of the earlier application whose priority has been claimed (Rule 43bis.1 and 66.7(b)).

Consequently it has not been possible to consider the validity of the priority claim. This opinion has nevertheless been established on the assumption that the relevant date in the claimed priority date.

2. ☐ This opinion has been established as if no priority had been claimed due to the fact that the priority claim has been found invalid (Rules 43bis.1 and 64.1). Thus for the purposes of this opinion, the international filing date indicated above is considered to be the relevant date.

3. Additional observations, if necessary:

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Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability;
citations and explanations supporting such statement

1. Statement

Novelty (N)	Claims	1-13	YES
	Claims		NO
Inventive step (IS)	Claims		YES
	Claims	1-13	NO
Industrial applicability (IA)	Claims	1-13	YES
	Claims		NO

2. Citations and explanations:

1. Reference is made to the following documents:

D1: WO 02/39358 A (SERFLEK CHRISTOPHER; HELE JOHN C
R (BM); WORLDINSURE LTD (BM); SCOTT) 16 May
2002 (2002-05-16)

D2: WO 03/034312 A (FOUTZ GREGORY L) 24 April 2003
(2003-04-24)

2. The present application does not satisfy the
requirements of PCT Article 33(3) because the
subject matter of claims 1-13 does not involve an
inventive step. The reasons are as follows:

2.1. Based on the features contained in the claims, the
only technical problem that can be discerned over
the prior art mentioned on pages 1 and 2 of the
description is that of further automating a
partially "manual" business method for concluding
contracts via a network.

The question of inventiveness must be considered
from the point of view of a software developer or
application programmer with the relevant expert
competence in the concept and structure of the

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Box No. V

Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability;
citations and explanations supporting such statement

existing partially "manual" business method.

The technical features used for this purpose in claims 1-13 (the application of evaluation means and the saving of business rules) are obvious features that a person skilled in the art would employ in order to solve the problem of interest without requiring any particular inventive step.

Furthermore, these features are also known from the search report citations, documents D1 and D2 (see also points 2.3 and 2.4 of the present report).

The subject matter of claims 1-13 thus does not involve an inventive step over the prior art cited in the description (PCT Article 33(3)).

2.2. On pages 2 and 3 of the description, the application mentions a further technical problem of providing a universal user interface. However, it is not clear what technical features of independent claims 1 and 10 contribute to the solution of this problem.

Although the **preamble** of independent claims 1 and 10 defines a user interface, this could, in combination with the other features, be both a universal user interface and a non-universal user interface.

For this reason, this technical problem mentioned in the description is not solved by the subject matter of claims 1-13.

Therefore, this technical problem should be removed

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Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability;
citations and explanations supporting such statement

from the description (PCT Rule 5.1(a)(iii)).

2.3. Independent claim 1 also does not involve an inventive step over document D1 within the meaning of PCT Article 33(3).

With regard to some of the features of claim 1, document D1, which is considered the closest prior art, discloses a

computerized transaction server for concluding contracts between a service user and a service provider ("intermediary web server" in figure 2; abstract), comprising

a user interface with a plurality of data entry modules comprising data entry fields for entering data relating to the object of the contract ("a profile can be collected over several screens, e.g. using hypertext forms with relevant questions" on page 2, lines 12-25; page 13, lines 14-16 and 22-23), said user interface for service users being used by means of terminals via a telecommunications network (figure 2; page 12, lines 12-13),

saved business rules that are allocated to one or more of said data entry fields ("underwriting rules" on page 13, lines 27-29),

evaluation means for evaluating the data values entered via said data entry fields based on said allocated business rules and for generating a corresponding evaluation result ("underwriting engine" on page 13, lines 22-32; "underwriting process" on page 22, line 5 to page 23, line 29),

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Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability;
citations and explanations supporting such statement

a plurality of different contract conclusion processes for displaying a contract price via the user interface, for requesting and receiving via the user interface an acceptance by the service user to conclude the contract and for saving a concluded contract (page 32, line 27 to page 33, line 13) [and]

controlling means for activating a first data entry module, for activating the evaluation means upon receipt of a positive evaluation result and for automatically selecting and activating another of the data entry modules or one of the contract conclusion processes as a function of said evaluation result ("computer program product" on page 35, lines 19-32; figures 3 and 10).

The subject matter of claim 1 differs from that of document D1 in that the transaction server comprises:

saved data rules that are allocated to the data entry fields and

validation means for verifying data values entered via said data entry fields based on said allocated data rules, for requesting corrections via the user interface based on said data rules and for generating a validation result.

However, the additional features of these claims have already been used for the same purpose in similar systems, namely the correction of errors made in data entry (cf. the prior art cited on pages

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Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability;
citations and explanations supporting such statement

2 and 3 of the description in the present application or document D2, in particular page 13, line 23 to page 14, line 18). If a person skilled in the art wished to achieve the same aim in a server as per document D1, he could easily apply these features to like effect to the subject matter of D1, as well. In this way, he would arrive at a transaction server as per claim 1 without thereby being inventive.

Therefore, the subject matter of claim 1 does not involve an inventive step over document D1 (PCT Article 33(3)).

2.4. Independent claim 1 also does not involve an inventive step over document D2 within the meaning of PCT Article 33(3).

Document D2 also discloses a server which, based on saved validation rules and business rules, automatically quotes prices for contracts between a service user and a service provider via a network.

The difference between the disclosure of document D2 and the subject matter of claim 1 lies in the fact that document D2 does not disclose any contract conclusion processes.

Proceeding from the disclosure of D2, the addressed problem can therefore be considered that of expanding the server according to D2 such that all contracts can be concluded via the network.

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Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability;
citations and explanations supporting such statement

The fact that a person skilled in the art must utilize other software programs ("contract conclusion processes") in order to solve the above problem is obvious. Moreover, a person skilled in the art knows from the prior art cited on pages 2 and 3 of the description in the present application or from document D1 (page 32, line 27 to page 33, line 13) that contracts can be concluded via a network if the appropriate software for this purpose is used.

Therefore, in order to solve the problem of interest, a person skilled in the art would modify the server known from document D1 to add contract conclusion processes as per claim 1.

In this way, said person would arrive at the subject matter of claim 1 without thereby being inventive.

The subject matter of claim 1 thus also does not involve an inventive step over document D2 (PCT Article 33(3)).

2.5. The same argumentation with respect to documents D1 and D2 applies accordingly to independent claim 10 as well.

Therefore, the subject matter of claim 10 also does not involve an inventive step over documents D1 and D2 (PCT Article 33(3)).

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Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability;
citations and explanations supporting such statement

2.6. Dependent claims 2-9 and 11-13 do not contain any features which, in combination with the features of any claim to which they refer back, meet the PCT requirements for inventive step (see documents D1 and D2 and the corresponding passages cited in the search report).

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Box No. VII Certain defects in the international application

The following defects in the form or contents of the international application have been noted:

If new claims are filed, the following points should also be taken into consideration:

1. The features known in combination from the prior art (see document D1) should be placed in the preamble of the independent claim (PCT Rule 6.3(b)(i) and (ii)).
2. Pursuant to PCT Rule 5.1(a)(ii), the description should cite documents D1 and D2 and briefly outline the relevant prior art contained therein.

The written reply should indicate **the difference between the subject matter of the new claim and the prior art according to documents D1 and D2 as well as the importance of this difference.**

3. When filing amended claims, the applicant should simultaneously adapt the description to the amended claims and clearly indicate what **technical** problem is solved (PCT Rule 5.1(a)(iii)).

When revising the application, particularly the introductory part and the statement of the problem or the advantages of the invention, care should be taken that the subject matter does not go beyond the subject matter of the application as originally filed (PCT Article 19(2) and PCT Article 34(2)(b)).

4. In order to facilitate the examination of the amended application with regard to PCT Article 19(2) and PCT Article 34(2)(b), the applicant is requested to

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Box No. VII Certain defects in the international application

submit the completed amendments on replacement sheets, as required by PCT Rule 66.8(a), and to indicate the passages in the original application on which these amendments are based.

The applicant is further advised that, owing to PCT Rule 66.8(a), the examiner in the PCT procedure may not make even these minor modifications.